REMARKS

This paper is filed in response to the Office Action, mailed on October 7, 2003. Claims 1-92 have been examined and stand rejected. Reconsideration of Claims 1-92 is respectfully requested.

The Rejection of Claims 1 and 8 Under 35 U.S.C. § 102(b)

Claims 1 and 8 are rejected under 35 U.S.C. § 102(b) as being anticipated by the Nienhaus reference. Applicants respectfully traverse the rejection for the following reasons.

As now amended, Claim 1 recites " . . . said data input system further comprises a speech recognition utility to convert a voice command into data characteristic of said crystallization trials."

For a reference to be anticipatory, the reference must exactly describe the claimed invention. Because the Nienhaus reference does not describe at least a data input system comprising a speech recognition utility to convert a voice command into data characteristic of a crystallization trial, the reference is not anticipatory. Accordingly, neither Claim 1 or Claim 8 is anticipated by the Nienhaus reference.

Furthermore, the Nienhaus reference does not remotely teach or suggest a data input system comprising a speech recognition utility to convert a voice command into data characteristic of a crystallization trial.

The Rejection of Claims 1-3, and 8 Under 35 U.S.C. § 102(e)

Claims 1-3, and 8 are rejected under 35 U.S.C. § 102(e) as being anticipated by DeTitta et al. (U.S. Patent No. 6,368,402). Applicants respectfully traverse the rejection for the following reasons.

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As now amended, Claim 1 recites " . . . wherein said data input system further comprises a speech recognition utility to convert a voice command into data characteristic of said crystallization trials."

For a reference to be anticipatory, the reference must exactly describe the claimed invention. Because the DeTitta et al. reference does not describe at least a data input system comprising a speech recognition utility to convert a voice command into data characteristic of a crystallization trial, the DeTitta et al. reference is not anticipatory. Accordingly, Claim 1 is not anticipated by the DeTitta et al. reference. Because Claims 2, 3, and 8 are directly or indirectly dependent from Claim 1, Claims 2, 3, and 8 are also not anticipated.

Furthermore, the DeTitta et al. reference does not remotely teach or suggest a data input system comprising a speech recognition utility to convert a voice command into data characteristic of a crystallization trial.

It is noted that the DeTitta et al. patent has a filing date of April 23, 2001, which is later than the filing date of August 2, 2000 of the present application. The DeTitta et al. patent may have an effective date of April 21, 2000, based on the provisional application No. 60/198,995. However, the present application also claims the benefit of a provisional application No. 60/146,737, filed on August 2, 1999. Accordingly, the effective date of the present application is believed to be earlier than the DeTitta et al. patent's earliest possible effective date.

For at least the reason of the claims not being anticipated, if not also for the fact that the present application has an earlier effective date than the DeTitta et al. reference, applicants respectfully request the withdrawal of the rejection of Claims 1-3, and 8.

The Rejection of Claims 2 and 3 Under 35 U.S.C. § 103(a)

Claims 2 and 3 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nienhaus. Applicants respectfully traverse the rejection for the following reasons.

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A *prima facie* case of obviousness requires that there be a suggestion or motivation either in the references or in the knowledge generally available in order to modify a reference or to combine references. There must be a reasonable expectation of success, and all of the claim elements must be found in the prior art.

The Examiner states that "[t]he Nienhaus reference . . . differs from the instant claims in the optical systems. However, in the absence of unexpected results, it would have been obvious to one of ordinary skill to determine through routine experimentation the optimum, operable means to observe the crystallization in the Nienhaus reference, as the use of optics in crystal growth is well known."

The Examiner's stated motivation or suggestion is overly vague as to be meaningless and simply begs the question. The stated motivation or suggestion amounts to an improper "obvious to try" rational which is not the standard under § 103. See the M.P.E.P. § 2145.X.B. Furthermore, it appears the Examiner has overlooked the claim limitations regarding a positioning system that are neither taught nor suggested by Nienhaus.

Claims 2 and 3 are patentable over the Nienhaus reference for all the foregoing reasons, if not also for the fact that Claims 2 and 3 depend from Claim 1,which is allowable over the Nienhaus reference.

The Rejection of Claims 4-7, and 64 Under 35 U.S.C. § 103(a)

Claims 4-7, and 64 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nienhaus or DeTitta et al. Applicants respectfully traverse the rejection for the following reasons.

As stated before, there must be a suggestion or motivation either in the references or in the knowledge generally available to modify a reference or to combine references. There must be a reasonable expectation of success, and all the claim elements must be found in the prior art.

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The suggestion or motivation cannot be based on hindsight after having read from the applicants' disclosure. See the M.P.E.P. § 2145.X.A.

The Examiner states that "in the absence of unexpected results, it would have been obvious to one of ordinary skill to determine through routine experimentation the optimum, operable means to allow the operator of the crystallization system in the DeTitta et al and Nienhaus references to input data using verbal commands."

The Examiner's stated suggestion or motivation is so vague as to be meaningless, and is nothing more than the subjective opinion of the Examiner. The stated suggestion or motivation amounts to nothing more than an obvious to try rationale, which is not the standard in finding obviousness. There is no suggestion in either the Nienhaus or DeTitta et al. references to input data using verbal commands, so one can assume that the Examiner has impermissibly relied on hindsight based on applicant's disclosure. Furthermore, the invention as defined by Claims 4-7 and 64 advantageously provides an increase in the speed with which crystallization trial results are entered into a database. The observer is relieved from repetitively looking away from the microscope to input the data as with the prior conventional systems. Such advantages would not have resulted from any combination or modification of the Nienhaus or DeTitta et al. references.

Accordingly, Claims 4-7, and 64 are clearly not unpatentable over Nienhaus or DeTitta et al. Furthermore, applicants believe the DeTitta et al. reference is an improper reference cited against the present application.

<u>The Rejection of Claims 9-63, and 65-92 Under 35 U.S.C. § 103(a)</u>

Claims 9-63, and 65-92 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nienhaus or DeTitta et al. Applicants respectfully traverse the rejection for the following reasons.

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As stated above, there must be a suggestion or motivation either in the references or in the knowledge that is generally available to combine references or to modify a reference. There must be a reasonable expectation of success, and all the claim elements must be found in the prior art. *The suggestion or motivation cannot be based on hindsight after having read from the applicants' disclosure.*

The Examiner states that "in the absence of unexpected results, it would have been obvious to one of ordinary skill to determine through routine experimentation the optimum, operable means to software to create and use the databases of the DeTitta et al and Nienhaus references in order to place the data in the ways that allow for easier access and creation."

The Examiner's stated suggestion or motivation is so vague as to be meaningless, and is nothing more than the subjective opinion of the Examiner. The suggestion or motivation amounts to nothing more than an obvious to try rationale, which is not the standard in finding obviousness. There is nothing to suggest or motivate to do what is defined by Claims 9-63 and 65-92. Applicants believe the Examiner has not shown the requisite burden for a *prima facie* case of obviousness.

Accordingly, Claims 9-63 and 65-92 are not unpatentable over the Nienhaus or DeTitta et al. references. Furthermore, applicants believe the DeTitta et al. reference is not proper prior art against the present application. Therefore, applicants respectfully request the withdrawal of the rejection of Claims 9-63 and 65-92.

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CONCLUSION

In view of the foregoing amendment and remarks, applicants submit that Claims 1-92 are allowable over the references of record. Accordingly, applicants request an early issuance of a Notice of Allowance. If there are any remaining questions or comments that may result in expediting the Notice of Allowance, the Examiner is invited to contact the applicants' attorney at the number provided below.

Respectfully submitted,

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